

REMARKS

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested. Claims 1-15, 20-24, 27, 28 and 30-33 are pending. Claims 1 and 12 are amended to correct typographical errors.

Rejection of Claims 20-24, 27, 28 and 30-33 Under 35 U.S.C. §103(a)

The Office Action rejects claims 20-24, 27, 28 and 30-33 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. (CharToon 2.0 Manual) ("Noot et al.") in view of Mayle et al. (U.S. Patent No. 6,018,774) ("Mayle et al.") and Poggio et al. (U.S. Patent No. 5,416,899) ("Poggio"). Applicants respectfully traverse this rejection and submit that one of skill in the art would not have sufficient motivation or suggestion to combine these references.

To establish a *prima facie* case of obviousness, the Examiner must meet three criteria. First, there must be some motivation or suggestion, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to combine the references. Second, there must be a reasonable expectation of success, and finally, the prior art references must teach or suggest all the claim limitations. The Examiner bears the initial burden of providing some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." MPEP 2142.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). MPEP 2143.01.

Furthermore, if the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the applicant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. Where the teachings of two or more prior art references conflict, the examiner must weigh the power of each reference to suggest solutions to one of ordinary skill in the art, considering the degree to which one reference might accurately discredit another. *In re Young*, 927 F.2d 588, 18 USPQ2d 1089 (Fed. Cir. 1991). MPEP 2143.01.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

With these principles in mind, Applicants respectfully submit that by preponderance of the evidence, one of skill in the art would not have sufficient motivation to combine Noot et al. with Poggio et al. and/or Mayle et al. In the Office Action, the Examiner correctly acknowledges that Noot et al. fail to teach where the image is received from the center and

received over a network and stored as a customized model in a private database for restricted access by the sender, wherein the receiving of the facial features marked by the sender further comprises defining by the sender a symmetry axis for a face of the entity such that rotation of the face is defined by an image plane by computing an angle between image boundaries and an imaginary line defined by a point at a chin, a point at a nose tip and a point at a top of a head of the face of the entity. However, the Office Action then asserts that Mayle et al. and Poggio et al. teach these features that are missing from Noot et al. and that “therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the method of H. Noot et al. with the teachings of Mayle et al. and Poggio et al. thereby allowing a variety of processing steps to be performed by the server.” These processes are asserted to including preventing the unauthorized use of personal images and obtaining a series of views or images of an object/head and generating animation of the object/head without an explicit 3-D physical model of the object/head. Applicants respectfully submit that when the suggestive power of each reference is objectively analyzed, that one of skill in the art would not have sufficient motivation or suggestion to combine these references.

First turning to Noot et al., we note that the cartoon modular system disclosed in Noot et al. relates to a tool that focuses on the design and animation of two-dimensional cartoon faces with feasible alternatives and other features which is why the CharToon 2.0 Manual on page 1 refers to designing 2½D faces and other graphical objects. It is clear from the teachings of Noot et al. that the focus and purpose of the software is to generate 2D faces with a cartoonish or schematic appearance which later can be animated. See page 10, lines 1-1-3 of Noot et al. In other documentations in which Noot and Ruttkay discuss the cartoon application, they distinguish the cartoon system as being developed in response to the more expensive cost of producing synthetic “realistic” 3D faces. For example, the paper entitled “Animated CharToon

Faces” by Ruttkay and Noot explain this very fact. See <http://www.cwi.nl/projects/FASECharToon/Papers/Npar/NparDefinitive.pdf>. In their introduction, they criticize the cost and time of production of synthetic realistic 3D faces and note that in many applications realism is not of major importance. Accordingly, they develop the CharToon animation system in which they enable the design and animation of two-dimensional faces. While Noot et al. write and explain that their cartoon software was developed in response to the expense and lack of need for three-dimensional faces, Applicants respectfully note the contrast in Poggio et al. in which they explain that, in column 2 starting at line 15, their present invention provides a computer method and apparatus for generating three-dimensional graphics and animations based on two-dimensional views and novel approximation techniques instead of a 3D physical model 3D based modeling as a prior art. In other words, it is clear from the introduction and summary of Poggio et al. that their focus is the synthesis and generation of three-dimensional graphics.

Accordingly, Applicants respectfully submit that there is an express distancing of the CharToon program from tools or approaches that seek to animate realistic three-dimensional faces as is taught in Poggio et al. While Applicants do not concede that the Noot et al. article entitled “Animated CharToon Faces” is prior art inasmuch as it is undated, Applicants note that one of skill in the art would be expected to be aware of this document and the purpose and reason behind the CharToon program. In other words, the knowledge of one of skill in the art has been demonstrated herein that there is certainly no suggestion or motivation to combine these references and that one of skill in the art by a preponderance of the evidence have an understanding of the express distancing of the Noot et al. CharToon development program from three-dimensional applications such as Poggio et al.

Applicants respectfully submit therefore that there exists a lack of suggestion or motivation in the art to combine these references. Furthermore, Applicants respectfully submit that the teachings of Mayle et al., which include system and method for creating messages including image information, relate primarily to a goal of allowing a user to create an electronic postcard composed of a user's digital photograph. There is no suggestion or motivation that can be found in Mayle et al. with regards to animation in two dimensions (Noot et al.) or three dimensions (Poggio et al.). For example, page 3 of the Office Action cites Mayle et al. as teaching that the image of the entity is to be used as the animated entity, citing columns 5, 7 and 10. However, nothing in these columns suggest anything regarding an animation which can be associated with the graphics. For example, in column 7, lines 7-20, they discuss graphical data which may be received from a digital camera, a video camera, a scanner or a film processor that provides electronic image data and a variety of graphical data formats may be used to encode the image information, but the preferred is discussed as JPEG or GIF format. There is nothing in this reference that would lead one to believe that animation is included within the scope of the disclosure. The reference to a video camera 14 cannot be used to provide this suggestion for the reason that most video cameras include the ability to record still images as would be known in the art. Accordingly, inasmuch as the entire teachings of the art discuss GIF and JIF format images and is in the context of teaching about the creation and display of an electronic postcard, there is certainly a lack of suggestion that animation is included within the scope of this invention. Similarly, column 10 fails to add anything further regarding any suggestion for animation. Lines 35-45, in fact, teach away from any such suggestion by again focusing on photos in a JPEG or GIF format and how such photos may be manipulated and used according to the disclosure of Mayle et al. Accordingly, when the suggestive power of Mayle et al. is objectively analyzed, Applicants respectfully submit that one of skill in the art would review this

reference and not have any suggestion or motivation to believe that its teachings would be combined with a two-dimensional animation program such as Noot et al. or the three-dimensional synthetic disclosure of Poggio et al. Accordingly, Applicants submit that these references are not appropriately combined under an obvious analysis and therefore claims 20-24, 27, 28 and 30-33 are patentable and in condition for allowance.

Rejection of Claims 1, 2, 4-6, 12 and 13 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 2, 4-6, 12 and 13 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al. and Poggio et al. and in further view of Ouhyoung et al. (Web-enabled Speech Driven Facial Animation) (“Ouhyoung et al.”). Applicants respectfully traverse this analysis and submit that these claims are patentable in view of the prior art.

As noted above, Applicants have set forth that by a preponderance of the evidence one of skill in the art would not have sufficient motivation or suggestion to combine Noot et al., Mayle et al. and Poggio et al. and accordingly, these claims are patentable. Furthermore, Applicants note that the rejection of claims 1, 2, 4-6, 12 and 13 requires the additional citation of Ouhyoung et al. whose paper is entitled “Web-enabled Speech Driven Facial Animation”. Applicants again submit that in addition to the lack of motivation to combine the primary three references that given Mayle et al. teach the electronic postcard with no hint or suggestion of ability or application to an animation context, that one of skill in the art would not have sufficient motivation to combine Ouhyoung et al., whose disclosure is clearly related to facial animations over the web, with the teachings of Mayle et al. and the other teachings as well. Accordingly, Applicants submit that claims 1, 2, 4-6, 12 and 13 are patentable and in condition for allowance.

Rejection of Claim 3 Under 35 U.S.C. §103(a)

The Office Action rejects claim 3 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al., Poggio et al. and Ouhyoung et al. and in further view of Grayson et al. (U.S. Patent No. 5,963,217) (“Grayson et al.”). Applicants respectfully submit that since claim 3 depends from claim 1 that it is allowable for the reasons set forth above.

Rejection of Claims 7, 8 and 14 Under 35 U.S.C. §103(a)

The Office Action rejects claims 7, 8 and 14 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al., Poggio et al. and Ouhyoung et al. and in further view of Francini et al. (U.S. Patent No. 6,532,011) (“Francini et al.”). Applicants respectfully traverse this analysis and submit that based on the analysis above, that one of skill in the art would not have sufficient motivation to combine Noot et al., Mayle et al., Poggio and Ouhyoung et al. and thus these claims are patentable and in condition for allowance.

Rejection of Claim 9 Under 35 U.S.C. §103(a)

The Office Action rejects claim 9 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al., Poggio et al. and Ouhyoung et al. and in further view of Shaw et al. (U.S. Patent No. 6,147,692) (“Shaw et al.”). Applicants respectfully traverse this rejection and submit that based on the analysis above, that claim 9 is patentable inasmuch as one of skill in the art would not have sufficient motivation or suggestion to combine Noot et al., Mayle et al., Poggio and Ouhyoung et al.

Furthermore, inasmuch as Shaw et al. teaches morphing a human face with an animation face and further teaches regarding realist morphing of animal and human facial features including realistic morphing of an animal and human teeth, that one of skill in the art would certainly not have sufficient motivation or suggestion to combine Shaw et al. with the remaining references. One clear example of this, as noted above, exists in that Noot and Ruttkay have

distanced their CharToon animation application from other applications in which there is considerable cost and time to produce synthetic realistic three-dimensional faces. Accordingly, inasmuch as Shaw et al. teach such realistic animations, one of skill in the art would recognize that there is an express distancing of the Noot et al. application with such teachings as in Shaw et al. Accordingly, for this additional reason, Applicants respectfully submit that claim 9 is patentable.

Rejection of Claim 10 Under 35 U.S.C. §103(a)

The Office Action rejects claim 10 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al., Poggio et al. and Ouhyoung et al. and in further view of Burson et al. (U.S. Patent No. 4,276,570) (“Burson et al.”). Applicants respectfully traverse this rejection and submit that based on the analysis above, that claim 10 is patentable inasmuch as these references should not be combined.

Rejection of Claims 11 and 15 Under 35 U.S.C. §103(a)

The Office Action rejects claims 11 and 15 under 35 U.S.C. §103(a) as being unpatentable over Noot et al. in view of Mayle et al., Poggio et al. and Ouhyoung et al. and in further view of Murata et al. (U.S. Patent No. 5,638,502) (“Murata et al.”). Applicants respectfully traverse this rejection and submit that based on the analysis above, that claims 11 and 15 are patentable inasmuch as one of skill in the art would not have sufficient motivation or suggestion to combine Noot et al. with Mayle et al. and Poggio et al.

CONCLUSION

Having addressed all rejections and objections, Applicants respectfully submit that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **The Law Offices of Thomas M. Isaacson, LLC, Account No. 50-2960** for any deficiency or overpayment.

Respectfully submitted,

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